

REMARKS

In the Final Office Action that was mailed on November 1, 2005, claims 1-18, 21-25, and 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of MacLeod. Claims 19-20 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall in view of McLeod and further in view of Cafarelli. Claims 26-29 were rejected as being unpatentable over Hall in view of MacLeod, and further in view of Liu. The foregoing objections are respectfully traversed.

Claims 1-34 are pending in the subject application, of which claims 1, 7, 14, and 17 are independent claims.

Entry of Amendment After Final Rejection:

The Applicant respectfully asserts that the amendments presented herein require only a cursory review by the examiner, and respectfully requests that the examiner enter such amendments.

Amendments to the Claims:

Claims 2, 8, 33, and 34 are amended herein to recite a library manager “that enables multiple client applications to share one or more removable media storage devices and manages removable media within an operating system.” Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claims 2, 8, 33, and 34 may be found in the Specification at page 11, lines 11-13.

Rejections of the Claims:

Rejection of Claim 1:

Lack of Motivation to Combine Hall and MacLeod:

MPEP § 706.02(j) requires that, to establish a prima facie case of obviousness under § 103, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why someone of ordinary skill in the art would have combined Hall and MacLeod. The examiner's sole support or motivation to combine Hall and MacLeod is that "MacLeod teaches the concept of using a device driver to poll a removable media storage device such as a disk for state information. It would have been obvious to apply the teachings of MacLeod to the system of Hall because this allows the computer system to get state information from any kind of removable storage devices, such as a disk drive as disclosed by MacLeod." (Office Action, p. 4). Someone of ordinary skill in the art of managing removable media storage devices would not have been attracted to MacLeod, which discusses method for input/output virtual address translation. **By extracting the relevant parts from each of the two references and combining those parts, the examiner has effectively recreated the patented invention by using the claim as a blue print. Neither Hall nor MacLeod discloses or suggests a motivation to combine with the other to achieve the claimed invention. The references themselves do not suggest the viability of making the combination, and someone of ordinary skill in the art would not think to combine them. Thus the references are not properly combined.** Therefore, the combination is improper and must be withdrawn.

Rejection of Claim 10:

Hall discusses that a GPIB application makes a notification request, which comprises event information regarding GPIB events to monitor, and that a GPIB driver level software determines whether

an event specified by the event information has occurred. Claim 10 recites “the initiated task alters the identification of media on the removable media storage device.” (emphasis added) Hall does not disclose or suggest that a client application can make a request to a device driver to alter the identification of media on the removable media storage device.

The examiner has not presented any evidence why someone of ordinary skill in the art would have modified Hall. Someone of ordinary skill in the art would not have read Hall as discussing removable devices that store media, nor would someone of ordinary skill in the art find it obvious to use Hall’s GPIB devices to store media. The mere fact that reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the modification. Id. The examiner’s sole support for such a modification is that “Hall as modified further teaches the initiated task alters the identification of media on the removable storage device.” (Office Action, p. 5) (emphasis added). The examiner cannot rely on the modification without first supporting the motivation to make the modification. Such motivation does not appear anywhere in the reference, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the modification of Hall; therefore, the modification is improper and must be withdrawn.

Rejections of Claims 21-23:

Hall discusses that there is a device driver for each GPIB device whereas claim 21 recites “the device driver comprises a class driver and a device-specific mini driver.” Hall does not disclose or suggest that a device driver comprises a class driver and a device-specific mini driver; a configuration that bears an advantage that one class driver can perform functions that apply to an entire class of devices.

The examiner has not presented any evidence why someone of ordinary skill in the art would have modified Hall. The mere fact that reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the modification. Id. The examiner’s sole support for such a modification is that “Hall as modified further teaches the device driver comprises a class driver and a device-specific mini driver.” (Office Action, p. 6) (emphasis added). The examiner cannot rely on the modification without first supporting the

motivation to make the modification. Such motivation does not appear anywhere in the reference, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the modification of Hall; therefore, the modification is improper and must be withdrawn. In addition, dependent claims 22 and 23 of the subject application are allowable based in part on their dependency from claim 21.

Rejections of Claims 33 and 34:

Lack of Motivation to Combine Hall, MacLeod, and Cafarelli:

The examiner has not presented any evidence why someone of ordinary skill in the art would have combined Hall, MacLeod, and Cafarelli. The examiner's sole support or motivation to combine Hall, MacLeod, and Cafarelli is that "Cafarelli further teaches a database that is updated by a library manager with an action taken in response to the change notification." (Office Action, p. 7). By extracting the cited parts from each of the three references and combining those parts, the examiner has attempted to recreate the patented invention by using the claims as a blue print. If the references themselves do not suggest the viability of making the combination, they are not properly combined. Neither Hall nor MacLeod nor Cafarelli suggests or teaches a motivation to combine the other two references to achieve the intended purpose of the claimed invention. Therefore, the combination is improper and must be withdrawn.

The References do not Disclose or Suggest the Claimed Invention:

The examiner rejected claims 33 and 34 as being unpatentable over Hall in view of MacLeod, and further in view of Cafarelli. Claim 33 and 34 (as amended herein) recite "a database that is updated by a library manager with an action taken in response to the change notification, wherein the library manager is an application that enables multiple client applications to share one or more removable media storage devices and manages removable media within an operating system." The examiner likens a sniffer application software process in memory in Cafarelli to the "library manager" in the claims. (Office Action, p. 7). However, the function that is performed by the sniffer application software process in Cafarelli is limited to providing the memory address of a statistic buffer memory to another software process in memory. This is far less than what the library manager of the claimed invention does. Therefore, even if Hall, MacLeod, and Cafarelli are combined, the combination still does not result in the claimed invention.


Withdrawal of the foregoing rejections is respectfully requested. The remarks herein are to be interpreted only in the context of the specific claims for which they are presented.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,

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